

REMARKS/ARGUMENTS

This paper responds to the Office Action of June 10, 2003. As noted in the Interview Summary attached hereto, that Office Action was withdrawn by Supervisory Examiner Millin in December 2003, and no Office Action is currently outstanding against this paper. Accordingly, this paper is timely.

I. Status of Claims

Applicant respectfully requests reconsideration of the application.

Claims 186-297 are now pending in the application. Claims 186, 187, 213, 225, 241, 252, 264, 282, 287 and 294 are independent. In view of the determination by Supervisory Examiner Millin that the examination of these claims was severely flawed, Applicant reinstates these claims, and requests examination.

These claims substantially reinstate claims 39-157 that were earlier added to claim additional aspects of the invention. Addition of these claims is not responsive to any statutory ground of rejection. The original claims were cancelled in response to the restriction requirement of March 2002, not any statutory ground relating to patentability.

The restriction requirement of March 2002 noted claims 39-157 were directed to a single invention, and these claims were considered together in the Office Action of October 2002. Thus, restriction among claims 186-297 is not warranted.

Support for claims 186, 187 and 213 is found at page 6, line 17 to page 7, line 3 of the original specification.

Support for claims 186, 225 and 241 is found at page 7, lines 4-21 of the original specification.

Support for claims 186 and 252 is found at page 6, line 17 to page 7, line 21 of the original specification.

Support for claims 186, 264 and 282 is found at page 14, line 21 to page 16, line 10 of the original specification.

Support for claims 186, 287 and 294 is found at page 19, lines 6-8 and page 20, lines 2-7 of the original specification.

Support for claim 186 is found at page 24, lines 18-28 of the original specification.

II. Replacement Specification

A Replacement Specification was filed on October 29, 2001. However, the application as published on March 20, 2003 (publication no. 20030055778 A1) uses the original specification. That Replacement Specification, with paragraph numbers added and minor further corrections in paragraphs [0020] – [0025], is resubmitted herewith. A markup copy as required by the rules in effect at in October 2001 was filed at that time. Applicant requests confirmation that any patent that ultimately issues will use the Replacement Specification.

III. Several Pages From The IMX.com and Lendingapps.com Web Sites Are Not Prior Art

The Office Action of June 2003 cites several web pages. Applicant notes that the following pages are not prior art:

- (1) IMX Technology Solutions for the Mortgage Industry
- (2), (3) and (4): Lending Apps (Company Overview, LoanSizer Technology, LoanSizer Product Family, LoanSizer Features)
- (8) LendingApps (Streamlining Workflow)
- (9), (10), (110), (12), (13) and (14): Lending Apps (LoanSizer Lender Software, Lender Pro, Lender Pipeline, Lending Matching Engine Registration)
- (5) Product Information
- (6) and (7): Special Deals (Find Commercial Loans Now), Fast Affordable Broker Web Sites

These pages bear copyright dates of the year 2000, and “printed” dates of October 2002. Some of these pages mention software (Windows ME and Windows 2000) that was not released until the year 2000. There is no evidence to suggest that these pages existed as of the filing date of this application, August 7, 1999.

It is also noted that these pages come from two different web pages, www.imx.com and www.lendingapps.com. There is no showing of “motivation to combine” these references.

These pages are not prior art. Any rejections based thereon may be withdrawn.

IV. Claims 186, 187, 213, 225, 241, 252, 264 and 282: “Secondary Markets”

Claims 186, 187, 213, 225, 241, 252, 264 and 282 recite certain transactions that take place on a “secondary” market.

The specification and claims draw a distinction between an “origination” market (also called a “primary” market or “original issue” market) and a “secondary” market. As explained in Barron’s Dictionary of Finance and Investment Terms, in an “origination” transaction, a party originates a new debt, or issues new stock or other securities. For example, when a home buyer or homeowner takes out a new mortgage loan, that is an “origination” transaction. In contrast, a “secondary” market is where existing debt, stock or securities are resold. Thus, when one bank sells a mortgage to another bank, that is a “secondary” transaction. The specification (Replacement Specification at page 1, lines 12-16) contrasts “origination” and “secondary transactions,” and gives a definition that is the same as the definition in the Barron’s Dictionary, attached as Exhibit A hereto (“Secondary transactions” involve the “buying and/or selling of existing” financial products).

The Office Action of June 2003 points to Fraser United States Patent No. 5,995,947 (hereinafter “Fraser ’947”) to show “secondary market” transactions. But Fraser ’947 only discusses origination. For instance, the “process flow” shown in Fraser ’947 Fig. 2 and discussed from col. 9, line 29 through col. 14, line 36 ends at “prequalification” (col. 14, line 18), that is when the lender has taken a “first look” at the borrower, and believes that there is a reasonable likelihood that the borrower will ultimately qualify. Fraser ’947 ends before the lender actually qualifies the borrower, let alone actually lends money to complete an “origination” transaction. Without an “origination,” Fraser ’947 cannot possibly discuss a “secondary transaction” on a “secondary market,” as recited in these claims. Fraser cannot anticipate or make obvious the claims that recite any activity relating to a “secondary transaction” or “secondary market.”

The Office Action points to “vertical integration”¹ as a rationale for the “secondary market” transactions recited in these claims. But “vertical integration” and “secondary market

¹ Applicant traverses this reliance on Official Notice – if this rationale is maintained further, Applicant demands substantial evidence pursuant to 37 C.F.R. § 1.104(d)(2) and MPEP § 2144.03 to show that it was known to use a sale between a buyer and a seller to achieve “vertical integration,” and that such a sale was known to be desirable.

transactions” are opposites – “vertical integration” is the result of combining two different stages of a commercial process into a single entity (for example, when Walt Disney bought ABC Television, so that Disney could produce movies, and ABC could serve as the sales channel). In contrast, a secondary market sale almost by definition occurs between two separate entities. Thus, “vertical integration” cannot be a proper motivation to modify Fraser ’947 in the manner claimed.

V. Claims 287 and 294: Directing a Borrower to a Best Lender

Claim 287 recites as follows:

287. A computerized method, comprising the steps of:
obtaining information from a loan applicant, the information relating to the qualifications of the applicant relative to underwriting standards of a plurality of lenders, for retail origination of a financial product;
receiving and storing underwriting standards from a plurality of lenders;
and
by computer, automatically matching the applicant’s information against underwriting standards of a plurality of lenders, and identifying to the applicant, from among those lenders having underwriting standards that the applicant meets, an indicium of the identity of the lender that has the best combination of low interest rate and fees.

The Office Action of June 2003 compares the computerized identification of a single lender with “the best combination of low interest rate and fees” to the disclosure on page (2) of “IMEX.”

As noted above, this page is not prior art – the only date thereon is 2002.

VI. Applicant Requests Clearer Statements of The Examiner’s Position

Applicant notes several aspects of the Office Action of June 2003 that are very unclear, and make it very difficult to respond directly.

First, it would very helpful if the Office Action were broken into numbered paragraphs. When it is not clear which particular comments and which particular references are directed to which particular claims, it become impossible to provide a response that responds directly to the Examiner’s concerns.

Second, Applicant would appreciate a clearer designation of the portion of references, by column and line number – with an ending line number. “*Et seq.*” is very unclear – it leaves Applicant to try to guess whether one line is thought pertinent, or fifty.

Third, the Office Action would be much clearer if it identified corresponding elements of the reference by name, in addition to location. Especially where no correspondence exists, it is very difficult to identify any analogy that the Examiner might be trying to draw.

The dependent claims pending earlier in prosecution were rejected without being compared to the art. Such piecemeal examination is discouraged by 37 C.F.R. § 1.105 and MPEP § 707.07(g). It is requested that any future Office Action indicate the allowability of any claim that recites a limitation against which no prior art is cited.

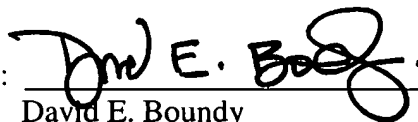
In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114459-05-E3.

Respectfully submitted,

WILLKIE FARR & GALLAGHER, LLP

Dated: April 12, 2004

By: _____



David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER, LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8000
(212) 728-8111 Fax